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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,434	02/28/2002	William L. Tonar	GEN-001323C3	4510
30981	7590	01/28/2010		
King & Partners, PLC 170 College Avenue SUITE 230 HOLLAND, MI 49423			EXAMINER TOSCANO, ALICIA	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 01/28/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/085,434	<b>Applicant(s)</b> TONAR ET AL.	
	<b>Examiner</b> Alicia M. Toscano	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

1. As previously set forth: Applicant's petition for unintentionally delayed claim to priority has been granted, as such the instant case has an effective filing date of 3/15/96.
2. Even in light of the above filing date the rejections set forth below stand. Tonar '283 now qualifies as a 102(e) reference. Rejections in view of Varaprasad still qualify as 102(b).

### ***Response to Arguments***

3. Applicant thanks the Examiner for her time during the recent telephonic interview, however, the Examiner has no record of such an interview. A proposed interview was set up in 10/09, however it was cancelled and no discussion of this case is known to have taken place in the recent past. The Examiner requests clarification.
4. Applicant requests the USPTO to withdraw its Official Communication dated 5/15/09 and either (1) Issue a notice of allowance, which was memorialized in an interview granted on 12/22/03, or (2) Withdraw from record the amendment and communication transmitted by Applicant on 12/22/03 which was submitted based on the Examiner interview dated 12/22/03. Applicant argues the present Examiner should give full faith and credit to the previous Examiner since the record is completely void of any clear error on behalf of the previous Examiner. Regarding the prior art rejections below,

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Applicant incorporates by reference and reinstates the traversal of the below rejections as set forth in Applicant's remarks dated 6/19/08.

The Examiner disagrees. The Examiner does not have the authority to expunge amendments and communications from the official record. For information on how Applicant may petition to withdraw such amendments and communications see MPEP Patent Rule 1.59:

**§ 1.59 Expungement of information or copy of papers in application file.**

(a)

- (1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
- (2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

As such arguments to withdraw are moot. Regarding withdrawal of the rejections based on the full faith and credit to the previous Examiner, the present Examiner disagrees. The previous Examiner was "in clear error" in giving patentable weight to a product by process limitation without a showing that a different product has been

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produced. Additionally, as set forth in the rejection below and previously, Varaprasad anticipates the use of polymers having a MW greater than 1000 in his monomer mixture, see page 18 lines 14-16, also see the various epoxy, acrylate, urethane acrylate, and similar polymer resins disclosed to be used in the monomer mixture on pages 16-18. Thusly, even if a different product is shown to be produced by using low molecular weight monomers, the MW requirements of the matrix before crosslinking are met based on the above resins. As such it would be improper for the current Examiner to issue a notice of allowance on the pending claims and arguments therein are thusly moot. Applicant's arguments as previously set forth are not persuasive, i.e. Applicant argues the priority claims overcome Tonar, the Examiner disagrees as set forth above, and Applicant argues affirmative, positive limitations, which are permissible and pertinent and were requested by Examiner Tucker overcome Varaprasad, the Examiner disagrees, the clauses therein are product by process limitations and Applicant has not shown a different product has been formed. As such the rejections stand and are reiterated in their entirety below.

***Terminal Disclaimer***

5. As set forth previously: Terminal disclaimers have been approved and recorded over US 5928572 and US 6248263.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 3-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Tonar (US 5679283).

This rejection is as set forth in the action dated 9/8/08, reiterated below in its entirety.

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Tonar discloses electrochromic layers and devices comprising them. Said devices comprise at least one transparent substrate coated with a layer of an electronically conducting coating, forming electrodes (Column 1 lines 47-55), and an electrochromic medium in between (abstract). The electrochromic medium is a crosslinked matrix (Column 6 line 42), wherein the polymers which are crosslinked may have a molecular weight of 2000 (Column 6 line 56) to 4800 (Column 12 line 54). Examiner finds 4800 to meet the “approximately 5000” requirement of the intervening

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claims. The crosslinking polymer is described as a free standing gel (Column 5 line 2) and does not significantly weep (Column 5 line 10), further meeting requirements of said component in claims 11-69. The elements discussed meet the limitations of claims 3-50. Since the elements of the device are met, the Examiner finds the "solid state" requirements of Claim 51 to be met. Regarding claims 52-69, use of about 50 wt% (Column 7 line 14), 19 wt% and 33 wt% (Table II) of the crosslinked matrix in the electrochromic medium is disclosed and thusly meets the limitations of the claims.

7. Claims 3-53, 54-56, 58-59, 61-62, 64-65 and 67-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Varaprasad (EP 612826 A1).

This rejection is as set forth in the action dated 9/8/08, reiterated below in its entirety.

Varaprasad discloses electrochromic polymeric films. Said films start as a monomer and are polymerized into polymers by exposure to electromagnetic radiation (abstract), resulting in a crosslinked matrix.

Pertaining to the independent claims the process of making the crosslinked matrix by crosslinking preformed non crosslinked polymer chains is viewed as product-by-process claims and hence the methods they are created by are not pertinent, unless applicant can show a different product is produced.

The MW requirements fall under the product by process claims, however even as such, the Examiner notes that the claimed MW ranges are met by use of PEG 200-8000 on pg 18 lines 14-16. Further, polymeric films may be prepared separately from the

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electrochromic device (Pg 20 lines 25-35), forming a free standing gel. The electrochromic polymeric medium is set between two conductive surfaces (pg 4 lines 19-20) wherein a coating of ITO may be deposited onto a substantially clear surface (pg 23 lines 56-58). It is the Examiner's position that the monomers of the crosslinking solution inherently act as a solvent for the various plasticizers and electrochromic elements of the composition, since the solution is homogeneous prior to crosslinking. Further, since the compositional elements are met, the Examiner finds the crosslinked matrix to inherently have free standing and non weeping characteristics.

Regarding claims 53, 54-56, 58-59, 61-62, 64-65 and 67-69, use of 21% monomer in the composition, which would result in 21% crosslinked matrix in the end product, is disclosed in Example 4 preparation A, meeting the less than 50 and 33 wt% requirements.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 54, 57, 60, 63, 66 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varaprasad.

This rejection is as set forth in the action dated 9/8/08, reiterated below in its entirety.



Varaprasad includes elements as set forth above. Varaprasad discloses the use of 21 wt% monomer in the crosslinking solution. Once crosslinked the composition would thusly have 21 wt% crosslinked matrix. Varaprasad does not disclose the use of less than 19 wt% of crosslinked matrix, as required by the above claims.

It has been held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985). It is the Examiner's position that there would be no difference between 19 wt% and 21 wt% crosslinked matrix, and thusly the range is found to be met by Varaprasad.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is (571)272-2451. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT

/RANDY GULAKOWSKI/

Supervisory Patent Examiner, Art Unit 1796